

REMARKS

Favorable reconsideration and allowance of the present application in view of the foregoing amendments and following remarks are respectfully requested.

Currently, claims 1 through 33 are pending in the application. Claim 1 is an independent claim, with claims 2 through 9 depending therefrom. Claim 10 is an independent claim, with claims 11 through 20 depending therefrom. Claim 21 is an independent claim, with claim 22 depending therefrom. Claim 23 is an independent claim, with claims 24 and 33 depending therefrom.

Applicants have carefully considered the Examiner's Action of March 19, 2003 and the references cited therein. The following is a brief summary of the Action.

Original claims 1, 2, 3, and 10 stand rejected under 35 U.S.C. § 102(b) for alleged anticipation by Schwartz et al (U. S. Patent No. 5,894,597). Original claims 1 through 10, 12 through 13, 15 through 16, 21 through 23, 25 through 26, and 28 through 29 stand rejected under 35 U.S.C. § 102(a) for alleged anticipation by Lu (DE 200 09 217).

Original claims 10, 14, 21 through 23, and 27 stand rejected under 35 U.S.C. § 102(a) for alleged anticipation by Tu (DE 200 13 259). Original claims 11, 17 through 20, 24, and 30 through 33 are objected to as being dependent upon a rejected base claim, but were indicated to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. There are no objections either to the drawings or to the specification.

Applicants respectfully submit that independent claim 1 as presently amended herein, and thus dependent claims 2 and 3, are allowable over Schwartz. To anticipate, every element and limitation of the claimed invention must be found in Schwartz.

Karsten Mfg. Corp. v. Cleveland Golf Co., 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001); Scripps Clinic & Research Foundation v. Genentech, Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). A determination of invalidity based on anticipation under 35 U.S.C. § 102(b) requires a finding that “each and every limitation is found either expressly or inherently in a single prior art reference.”

Celeritas Techs. Ltd. v. Rockwell Int'l Corp., 150 F.3d 1354, 1360, 47 USPQ2d 1516, 1522 (Fed. Cir. 1998). However, Schwartz does not disclose the amended limitation of claim 1, “said housing in electrical communication with both said first card holder slide assembly and said second card holder slide assembly.” To the contrary, as shown in Figs. 5 through 10 of Schwartz, and as disclosed, for example, in claim 1 of Schwartz, the first card holder “moves away from the contact when a second [card holder] is inserted...” (Col. 6, ll. 23 – 24). As elaborated in Schwartz:

“In this alternate embodiment, the chip card support 104 will move out of the path of the large card 108 when the chip card 101 is in the chip card support 104 and when the chip card is not in the chip card support 104, allowing both cards to be mounted. However, when a large card 108 is loaded in the communication device, and a chip card is loaded in the chip card holder, the large card 108 will be positioned between the chip card and the contact assembly.” (Schwartz, Col. 3, l. 62 through Col. 4, l. 3)

Thus, Schwartz only discloses carrying two cards on a single device, but does not disclose electrical communication with both card holders. Indeed, the disclosure of Schwartz is inconsistent with electrical communication with both card holders at once. Because the limitation of the housing being in electrical communication with both the

first card holder slide assembly and the second card holder slide assembly is not disclosed by Schwartz, Schwartz cannot anticipate claim 1 pursuant to 35 U.S.C. § 102(b). Because claims 2 and 3 depend from claim 1 and therefore also include the presently amended limitation of claim 1, neither can Schwartz anticipate them. For these reasons, claims 1, 2, and 3 should be allowed over Schwartz.

Additionally, as to the asserted rejection of original independent claim 10 based on Schwartz, Applicants respectfully traverse. Original claim 10 includes as a last limitation, "wherein the first set of electrical contacts engage the first SIM card and the second set of electrical contacts engage the second SIM card." As observed in the preceding paragraph hereinabove, Schwartz's disclosure does not contain such a configuration and instead is inconsistent with electrical contact engagement with both cards at once – with Schwartz, insertion of the second card removes the first card from electrical engagement. Therefore, Schwartz cannot anticipate original claim 10.

As to the rejections under 35 U.S.C. § 102(a) based on Lu and Tu, included with this Amendment are Declarations pursuant to 35 U.S.C § 1.131 signed by the inventors. The Declarations establish that the inventors conceived the claimed invention prior to the effective dates of Lu and Tu. The Declarations also contain facts that establish due diligence from prior to Lu (the earlier of the two cited references) to the filing date of the present application. In view of the Declarations, it is requested that Lu and Tu be removed as prior art. In view of the fact that Lu and Tu should be removed as prior art, it is believed that the claims against which those references had been cited (original claims 1 through 10, 12 through 16, 21 through 23, and 25 through 29) are currently in condition for allowance.

Finally, Applicants request amendment of the specification, on page 11, to correct a typographical error detected upon Applicants' consideration of the Examiner's Action.

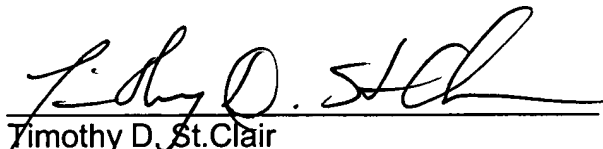
In view of the foregoing amendments and comments, inasmuch as all outstanding issues have been addressed, Applicants respectfully submit that the present application is in complete condition for issuance of a formal Notice of Allowance, and action to such effect is earnestly solicited. Should any issues remain after consideration of the within response, however, the Examiner is invited to telephone the undersigned at convenience.

If any fee beyond that submitted herewith, or extension of time is required to obtain entry of this Amendment, the undersigned hereby petitions the Commissioner to grant any necessary time extension and authorizes charging Deposit Account No. 04-1403 for any such fee not submitted herewith.

Respectfully submitted,

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